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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,979	09/17/2003	Daniel M. Marks	110293.133US1	1953
24395	7590	08/24/2006	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 1875 PENNSYLVANIA AVE., NW WASHINGTON, DC 20004			THOMASSON, MEAGAN J	
			ART UNIT	PAPER NUMBER
			3714	
DATE MAILED: 08/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

58

Office Action Summary	Application No.		Applicant(s)	
	10/663,979		MARKS ET AL.	
	Examiner		Art Unit	
	Meagan Thomasson		3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 2-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-10-04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 2-26 are objected to because of the following informalities:
 - Claims 2-26 refer back to the method of claim 1 in the dependent form, stated as "A method of claim 1...". Because claim 1 discloses only a single method of playing a game, subsequent dependent claims should refer back to the method disclosed in claim 1 as "The method of claim 1". Appropriate correction is required.
 - Based on 37 CFR 1.75(c), claims 2-26 are objected to in that the claim must depend in full from a prior claim. The claims will be examined as though the dependent claim depends fully on the claim, not simply the subsection of the claim. For example, in claim 5, this claim will depend on each of the limitations found in claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 1, 25 and 26, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 7, 8, 11-17, and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Bussick et al. (US 7,070,502 B1).

Bussick et al. discloses an electronic gaming device and method wherein a player places a wager, a plurality of symbols are arranged and displayed, including wildcard symbols, wherein said wildcard symbols are expandable in a plurality of directions. The player is then awarded based on various symbol combinations.

In column 9, line 66 – column 10, line 3, Bussick et al. discloses that “It should be appreciated that the present invention contemplates the game replacing or substituting one or more symbols of a reel, row, diagonal line of symbols or any combination thereof unassociated with or not containing the generated wild symbol”.

Further, Bussick et al. discloses that “It should also be appreciated that the implementor of the present invention can design one or more reels or otherwise design a game wherein the player is guaranteed or predetermined to obtain one or more wild symbols” in column 7, lines 53-57.

Bussick et al. discloses that the direction(s) and number of directions of the expansion of said wild card symbols is determined by the game, or processor, in column 15, line 33 – column 16, line 11, stated as “A slot machine comprising...a processor which controls said reels, wherein said processor: ... if said wild symbol occurs in the first set, said wild symbol causing a substitution of another one of the non-wild symbols in said first set with another wild symbol at each of the plurality of generated symbols on the reel with the wild symbol to create a second set of symbols that is displayed in place of the first set of symbols”.

Column 8, lines 19-21 disclose the expansion of the wild symbol as unidirectional, stated as “a preferably randomly generated wild symbol 110 replaces every other symbol on a reel associated with or containing the wild symbol 110”. This teaches that the expansion of the wild symbol is limited to expansion in the vertical direction. In a second embodiment, Bussick et al. discloses the limited expansion of the wild symbol in the horizontal direction in column 8, lines 47-50, stated as “a preferably randomly generated wild symbol 110 on a central display device 30 replaces all the non-wild symbols on a row associated with or containing the wild symbol 110”. This teaches that the expansion of the wild symbol is limited to expansion in the horizontal direction. At the time of the invention, it would have been obvious to one of ordinary skill in the art to limit the direction of expansion to only upwards and/or only downwards, as the concept of limiting the expansion directions of wild symbols is not novel.

Art Unit: 3714

Further, Bussick et al. discloses the wild symbol as replacing a limited subset of other symbols to form a winning combination, wherein the row or column containing the wild symbol is a limited subset of all other displayed symbols

Still further, Bussick et al. discloses issuing awards for winning symbol combinations before and after the expansion of wildcard symbols into adjacent symbol positions in column 3, lines 26-32, stated as "It is therefore an object of the present invention to provide a gaming device wherein one symbol substitutes for or replaces another symbol, and wherein the game provides awards for all winning symbols and winning combinations of symbols before said substitution or replacement and for all winning symbols and combinations of winning symbols after said substitution or replacement".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, 9, 10 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bussick et al. (US 7,070,502 B1) further in view of Rothschild et al. (US 6,786,818 B1).

Bussick et al. discloses an electronic gaming device and method wherein a player places a wager, a plurality of symbols are arranged and displayed, including

Art Unit: 3714

wildcard symbols, wherein said wildcard symbols are expandable in a plurality of directions. The player is then awarded based on various symbol combinations.

Bussick et al. does not disclose player selection of the direction(s) of the expansion of said wild symbols, nor does Bussick et al. disclose a scatter pay method of award. Further, Bussick et al. does not disclose a bonus award for overlapping wild symbols.

Rothschild et al. discloses an electronic gaming device and method wherein a player places a wager, a plurality of symbols are arranged and displayed, including interacting special symbols, wherein said interacting special symbols are expandable in a plurality of directions. The player is then awarded based on various symbol combinations.

The interacting special symbols disclosed by Rothschild et al. expand into the symbol matrix at the player's discretion, as stated in column 6, lines 8-16, wherein "The outcome of the interplay may be preselected, randomly selected, or may depend on an input from the player of the game. For example, in the first embodiment, the player may use an input device such as a lever or button to influence the timing of the quarterback's attempt to pass the football, the direction of motion of running receiver or quarterback. Also, the player may use the input device to select the type of play ... executed on the display". This teaches the claim limitations that the player may choose the direction and number of directions of the symbol expansion.

Rothschild et al. discloses awarding symbols combinations that appear along a payline as well as awarding symbols combinations that constitute line and reel scatter

Art Unit: 3714

pays, in column 9, lines 28-29, stated as "A player could win along a scatter pay line".

Further, it would be obvious for the implementor to restrict the method of awarding payment to paylines, line scatter, or reel scatter at the implementor's discretion.

Further, Rothschild et al. discloses a winning symbol combination that includes interacting special symbols in column 8, lines 11-13, stated as "an interplay can cause changes to the payout schedule, so that symbol combinations result in payouts other than the payout that would have occurred without the interplay", and column 8, lines 66-67, stated as "an interplay may trigger a second screen bonus round". These interacting special symbols are overlapping, as they expand to simultaneously occupy a single symbol position.

It is obvious to combine the teachings of Bussick et al. and Rothschild et al. due to their similar subject matter, namely electronic gaming devices and methods wherein a player places a wager, a plurality of symbols are arranged and displayed, including special symbols, wherein said special symbols are expandable in a plurality of directions. The player is then awarded based on various symbol combinations.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent prior art includes:

- Hughs-Baird et al. (US 6,981,635 B1) discloses a gaming device having interacting symbols.

Art Unit: 3714

- Baerlocher et al. (US 6,561,900 B1) discloses a gaming device with traveling reel symbols.
- O'Halloran (US 6,439,993 B1) discloses a method for operation of a gaming device with multiple wildcard symbols.
- Bennett (US 6,089,977) discloses a slot machine game with moveable wild card.
- Barrie (US 5,980,384) discloses a gaming apparatus and method having a wild symbol that creates interaction between symbol positions.
- Weiss et al. (US 6,875,106 B2) discloses a gaming device and method featuring moveable bonus indicia.
- Baerlocher et al. (US 6,565,433 B1) discloses a gaming device with traveling reel symbols.
- Rodgers et al. (US 6,997,808 B2) discloses a gaming device having transforming symbols.
- Jaffe (US 6,517,432 B1) discloses a gaming machine with moving symbols on the symbol array.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

Art Unit: 3714

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT


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PRIMARY EXAMINER